<u>REMARKS</u>

Reconsideration and allowance of this application are respectfully requested in light of the above amendments and the following remarks.

Claims 26, 27, 38, 39 and 45 are amended to recite subject matter of now canceled claims 50-52. The previously recited operation in independent claims 26, 38 and 45 of "not setting the happy-bit, if the user equipment transmits uplink data via the E-DCH without utilizing the maximum amount of uplink resources for scheduled uplink data as allowed by scheduling grants" has been moved to dependent claims 27 and 39.

The Advisory Action refers to 3GPP '309, which states that if both criteria 1) and 2) as recited in section 9.3.1.2 of 3GPP '309 are met, the UE shall indicate that it is unhappy, and otherwise, the UE shall indicate that it is happy. The Advisory Action concludes that this subject matter reads on the Applicants' claims.

It is submitted that the conclusion asserted in the Advisory Action is incorrect.

It is well-settled that, in order to establish either *prima facie* anticipation or obviousness of a claimed invention, all the claim limitations must be disclosed in the applied prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In other words, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Advisory Action and Final Rejection have ignored this requirement as follows. In the present invention, the happy bit is set only if all three conditions a), b) and c) of claims 26, 38 and 45 are met. However, the Advisory Action and Final Rejection completely ignore the

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recited condition c) that "the user equipment is utilizing the maximum uplink resources set by scheduling grants for scheduled uplink data transmission." Thus, it is submitted that, due to this deficiency, the 35 USC 102 rejection asserted in the Final Rejection is unfounded and should be withdrawn.

It is without question that, in 3GPP '309, there is no mention at all of a condition that "the user equipment is utilizing the maximum uplink resources set by scheduling grants for scheduled uplink data transmission," as recited in the instant independent claims, and the UE in 3GPP '309 does not check whether uplink data is transmitted via the E-DCH without utilizing the maximum amount of uplink resources for scheduled uplink data as allowed by scheduling grants. The Advisory Action and the Final Rejection do not even allege that 3GPP '309 performs this operation. To the contrary, in fact, 3GPP '309 excludes such a checking step because the UE is required to set the happy bit if criterion 1) and 2) are met; this requires setting of the happy bit regardless of whether or not uplink data is transmitted via the E-DCH without utilizing the maximum amount of uplink resources for scheduled uplink data as allowed by scheduling grants. 3GPP '309 is unconcerned with whether or not uplink data is transmitted via the E-DCH without utilizing the maximum amount of uplink resources for scheduled uplink data as allowed by scheduling grants. Accordingly, it is apparent that 3GPP '309 operates such that the UE will set the happy bit to request more UL resources even though the UE is not currently utilizing the maximum amount of UL resources as allowed by scheduling grants.

In view of the above, it is submitted that this application is in condition for allowance, and a notice to that effect is respectfully solicited.

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If any issues remain which may best be resolved through a telephone communication, the examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,

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